

Response to OA of January 4, 2005

Ser. No. 09/990,837

REMARKS

Applicant graciously appreciates the Office's attention to the instant application. In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application. This amendment is
5 believed to be fully responsive to all issues raised in the January 4, 2005 Office Action.

Rejections under 35 U.S.C. §112, ¶2

The Office rejected claims 2 and 3 under 35 U.S.C. §112, ¶2 as being
10 indefinite. In particular, the Office states that the term "the file" in line 1 of claim 2 lacks sufficient antecedent basis. Applicant disagrees. The body of claim 1 recites "a file" and "an additional file". Thus, Applicant respectfully submits that "a file" of claim 1, is "the file" of claim 2 and that the same logic pertains to claim 3. For further clarity, however, Applicant has amended the preamble of claim 1
15 to delete reference to "a file". Applicant submits that this amendment does not narrow the scope of claim 1 and that it is not made with respect to any reference for a reason related to patentability.

Rejections under 35 U.S.C. §102(b): Yan (USPN 6,003,065)

The Office rejected claims 1, 4-7, 9-13, and 16-19 as being anticipated
20 by Yan et al. (USPN 6,003,065, referred to as the Yan reference) under 35 U.S.C. §102(b).

Claims 1, 4-7 and 9-12

Claim 1 recites in part: "*executing the applet on the client to thereby
25 cause searching for an additional file*" and "*communicating the additional file to the server*". Applicant submits that the Yan reference does not disclose such searching and communicating.

Under 35 U.S.C. §102(b) "a claim is anticipated only if each and every
30 element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (MPEP §2131). Further, to properly

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reject a claim as anticipated, a reference "must enable one skilled in the art to make and use the apparatus or method". Beckman Instruments, Inc. v. LKB Produktur AB, 892 F.2d 1547, 1551 (Fed. Cir. 1989).

As discussed below, in response to the 35 U.S.C. §103 rejection, the

5 Yan reference pertains to a solution to obviate the need for device drivers (see, e.g., col. 9, lines 59-61). To accomplish this task, the Yan reference discloses use of specialized applications. However, such specialized application do not execute on a client to thereby cause searching for an additional file and communication of the additional file to a server, as recited in claim 1.

10 In support of the 102 rejection, the Office cites column 23, line 66 to column 24, line 4 for the proposition that the Yan reference discloses the searching of claim 1. At column 23, line 62 to column 23, line 12, the Yan reference states:

15 At a predetermined time period, an application running on a host computer can download applications, or applets, into each peripheral device and gather very detailed information on the peripheral device operation. The peripheral device, such as a printer, can execute the applet and determine what areas of the peripheral device need repair or are close to being depleted. Next, the peripheral device can

20 establish a bi-directional communication link to provide status on the peripheral device. If the peripheral device is a printer, this information may include information on the amount of paper available, amount of toner, time remaining before a service, or cleaning. Using this

25 information, the application running on the host can determine which peripheral device should be used and which peripheral device should not be used. In another aspect, these applications are advantageous because a single vendor can develop one application which interoperates with all peripheral devices having a virtual machine instruction processor and adhering to teachings provided by the

30 present invention.

Yan reference at col. 22, line 62 to col. 23, line 12.

Applicant submits that there is no evidence in this segment of the Yan

35 reference that discloses or suggests searching for an additional file as presented in claim 1. In particular, "gathering very detailed information on the peripheral device operation" (where operation pertains to repair, amount of

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paper available, amount of toner, time remaining before a service or cleaning), does not equate to searching for an additional file.

While the Yan reference discloses calls such as "GetPicture()" and "GetFiles()" (col. 18, lines 12 and 18, respectively), these system calls are for use by a peripheral device in relationship to another peripheral device. Thus, the Yan reference does not disclose "executing the applet on the client to thereby cause searching for an additional file" and "communicating the additional file to the server", as recited in claim 1.

Claims 4-7 and 9-12 depend on claim 1 and are believed patentable over the Yan reference for at least the same reasons as claim 1.

Claims 13 and 16-19

Claim 1 recites in part: "executing the applet on the client to thereby cause searching for an additional file", "communicating the additional file to the server" and "configuring the server using at least the additional file". Applicant submits that the Yan reference does not disclose such searching, communicating and configuring. As to the searching and communicating, Applicant refers the Office to the response above for claims 1, 4-7 and 9-12.

The Office states that the Yan reference discloses "configuring the server using at least the additional file" at column 23, lines 58-65 or columns 23 and 24, lines 66-67 and 1-4 (OA at page 4). The latter section appears above and has been discussed. The former section, column 23, lines 58-65, states:

For example, an applet could be downloaded into a printer peripheral device which causes the printer device to use a TimesRoman font, print landscape, and use papers initially from tray 1. This self-configuring option would speed up initial printer configuration significantly and allow for printer devices to be relocated on a network with minimal impact on the user community.

Yan reference at col. 23, lines 58-65.

As the Yan reference aims to obviate the need for device drivers, it is not surprising that it discloses "self-configuring" or peripheral devices. Applicant

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submits that this evidence does not support configuring of a server as recited in claim 13. Thus, Applicant submits that claim 13 is patentable over the Yan reference.

Claims 16-19 depend on claim 13 and are believed patentable over the Yan reference for at least the same reasons as claim 13.

Rejections under 35 U.S.C. §102(b): Adolfsson (USPN 6,092,078)

The Office rejected claims 21-24 as being anticipated by Adolfsson (USPN 6,092,078, referred to as the Adolfsson reference) under 35 U.S.C.

§102(b).

Claim 21, as currently amended, recites: *A method for configuring a Web server comprising:*

communicating a file from a client to the server, the file containing information;

generating an applet based on the information;

communicating the applet from the server to the client;

executing the applet on the client to thereby cause searching by the client for an additional file;

communicating the additional file to the server; and

configuring the Web server using at least the additional file.

Applicant submits the the Adolfsson reference does not disclose "executing the applet on the client to thereby cause searching by the client for an additional file" as recited in claim 21. At col. 5, lines 12-20, the Adolfsson reference discloses a network enabling input output device (NEIOD), which is a server that searches "for data providing means 3204-3210 that have a connection to it". Also, at col. 4, lines 19-40, the Adolfsson reference discloses a browser that executes an applet 3108 that sends a request to the NEIOD 3106, which is a server. As such, the Adolfsson reference does not disclose the searching by the client of claim 21.

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Claims 22-24 depend on claim 21 and are believed unanticipated by the Adolfsson reference for at least the same reasons as claim 21.

Cancelled Claims and New Claim

5 Claims 25-32 are cancelled. Claim 33 is new

Rejections under 35 U.S.C. §103(a)

10 The Office rejected claims 2, 3, 8, 14, 15 and 20 as being unpatentable under 35 U.S.C. §103(a) over Yan et al. (USPN 6,003,065, referred to as the Yan reference) in view of Brother ("Mass Deploying Windows Drivers in Windows 2000", referred to as the Brother reference). Applicant disagrees and submits that the Office has failed to make a prima facie case of obviousness. In particular, as discussed below, the Yan reference presents a solution that aims to alleviate the need for device drivers. Therefore, one of ordinary skill in the art
15 would not be motivated to uncover and read a document pertaining to printer drivers (i.e., the Brother reference). As such, there is insufficient objective evidence of record that would suggest or motivate one of ordinary skill in the art to combine the teachings of the Yan reference and the Brother reference.

20 The Office's burden under 35 U.S.C. §103(a) is set forth in the M.P.E.P., which states:

25 To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable
30 expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

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M.P.E.P. § 2142.

As stated in In re Lee, 61 USPQ.2d 1430, 1433, 1434 (Fed. Cir. 2002), "the factual inquiry whether to combine references must be thorough and searching" and based on objective evidence of record (internal citations omitted). Further, it is improper to combine references where the references teach away from their combination.

Applicant respectfully submits that the record lacks objective evidence sufficient to support a prima facie case of obviousness. In particular, the Yan reference teaches away from combination with the Brother reference. The Yan reference addresses limitations of systems that use device drivers and solves this problem by "obviating" the need for device drivers. Consider the following excerpts from the Yan reference:

"This [a single printer management application] would enable a user to select the printer device best suited for the print job rather than the printer compatible with the loaded device drivers" (col. 3, lines 39-41, emphasis added);

"Applications written to work with one brand and make of peripheral device should also be able to function with another brand and make of a peripheral device without loading new drivers, new software, or new versions" (col. 5, lines 6-10, emphasis added);

"This [peripheral API 288] obviates the need to support different device drivers for each application and/or operating system combination" (col. 9, lines 59-61, emphasis added); and

"For example, a user who wants to print a particular graphic format file such as a JPEG file on a printer does not have to use a driver to convert the JPEG file into the format prescribed by the printer such as PostScript" (col. 22, lines 25-29, emphasis added).

Thus, Applicant submits that one of ordinary skill in the art would not be motivated to combine the Brother reference with the teachings of the Yan reference when seeking to deploy drivers. Indeed, Applicant submits that the

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Yan reference is evidence of unobviousness of the subject matter of claims 2, 3, 8, 14, 15 and 20.

Claims 2, 3, 14 and 15

5 Claims 2, 3, 14 and 15 recite an "INF file". The instant Specification at page 8, lines 2-3 states: "Usually, a vendor supplies an INF file that installs vendor files related to a vendor's device." Indeed, INF files are typically associated with vendor devices and often used in installation of drivers for the vendor's devices.

10 At page 7 of the Office Action, the Office states that the Yan reference "fails to disclose that the file comprises an INF file". Applicant agrees and submits that, as the Yan reference aims to "obviate" the need for device drivers, it is not surprising that the Yan reference fails to mention INF files. For at least the reasons stated above, Applicant submits that claims 2, 3, 14 and 15 are
15 unobvious over the Yan reference in view of the Brother reference.

Claims 8 and 20

 Claims 8 and 20 recite "searching a CD in a CD-ROM drive". The instant Specification states at page 10, lines 13-14: "Note that the CD-ROM drive 352
20 also includes files 372, which are germane to configuration of the server 302." Indeed, files germane to configuration of a server are often provided by a vendor embodied on a CD.

 At page 7 of the Office Action, the Office states that the Yan reference fails to disclose searching a CD in a CD-ROM drive. Applicant agrees and
25 submits that it is not surprising that the Yan reference fails to mention such searching as is associated with, for example, files for device drivers. For at least the reasons stated above, Applicant submits that claims 8 and 20 are unobvious over the Yan reference in view of the Brother reference.

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Conclusion

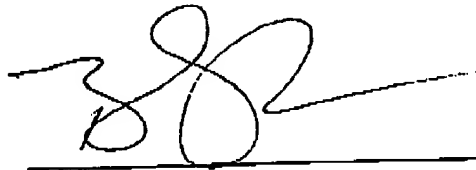
Claims 1-24 and 33 are pending and believed to be in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the present application. Should any issue remain that prevents
5 immediate issuance of the application, the Examiner is encouraged to contact the undersigned attorney to discuss the unresolved issue.

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